

stored in the server over the network; selecting advertisement information among information stored in the server when access is authorized; sending selected advertisement information from the server to the exhibitor over the network, wherein the selected advertisement information is a questionnaire, and a response to the questionnaire is communicated over the network from the audience to the server, and wherein the advertisement information sent to the exhibitor is transmitted to a movie theater and shown to the audience before or after a feature presentation as a digital motion picture projected from a movie projector.

The present invention includes bidirectional communications to a large number of clients. A digital image projected from a projector apparatus includes advertisement information that is presented to the large number of clients in a movie format. The present invention receives opinions from a large number of clients by questioning the audience in a movie theater either before or after the feature presentation. Between movies and on the theater screen, the audience interactively exchanges information with the server.

Franke discloses a method and system for conducting multiple Internet-based conventions, events, conferences, trade shows, and meetings. In this method and system and exhibition is performed using the internet, events, and a conference operating system, wherein various pieces of information, i.e., event names, dates, themes, etc., are stored in the database, and a user of the database accesses the desired subject matter through a search based on various search terms. *Franke* fails to disclose, teach, or suggest at least sending selected advertisement information from the server to the exhibitor over the network, wherein the selected advertisement information is a questionnaire, and a response to the questionnaire is communicated over the network from the audience to the server, and wherein the advertisement information sent to the exhibitor is transmitted to a movie theater and shown to the audience before or after a feature presentation as a digital motion picture projected from a movie projector. In fact, there is no discussion in *Franke* of sending an advertisement as a questionnaire as recited in the claims. Applicant further submits that the "search engine system" as disclosed by *Franke* does not present advertisement information in the form of a questionnaire, as recited in the claim.

The Office Action acknowledges that *Franke* fails to disclose, teach, or suggest at least that the advertisement information sent to the exhibitor is transmitted to a movie theater and shown to the audience before or after a feature presentation as a digital motion picture projected from a movie projector and relies on Official Notice to remedy this deficiency. However, the

Office Action fails to explain how or why the system for conducting cyber conventions could be implemented in a movie theater environment. In particular, without evidence outside of Applicant's disclosure that a cyber convention or similar system could be applicable in a movie theater setting, the statement that this element would have been well-known to one of ordinary skill is merely conclusory. Moreover, based on the argument as a whole and lack of documentary support it appears that the only basis the Office Action has in reaching this conclusion is through hindsight reasoning, which is impermissible.

Applicant adds that even if the methods and system of *Franke* could be used in a movie theater environment, which Applicant believes it cannot, the resulting system would still fail to render the claimed invention obvious. Namely, because *Franke* fails to disclose, teach, or suggest at least sending an advertisement as a questionnaire.

In a memo to the Examining Corps and Technology Center Directors, Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy, stated that reliance on "Official Notice" when an application is under final rejection should be rare. See "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice," United States Patent and Trademark Office, memo from Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy, page 2 (February 2002). Moreover, Mr. Kunin stated, "[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." See *Id.* "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." See *Id.*

In addition, if the Examiner believes that claim 1 still reads on a prior art reference, Applicant hereby requests that either:

- (a) The next Office Action be a non-final Office Action withdrawing Official Notice, and applying a suitable reference for the asserted rejection; or
- (b) The next Office Action include another rejection of claim 1 under an appropriate statutory provision providing an affidavit or suitable reference attesting to all the elements taken as Official Notice.

By this reply, Applicant has timely challenged the Examiner's Official Notice.

Still further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success required to establish a *prima facie* case for obviousness must

both be found in the prior art, not in the applicant's disclosure. See In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). It is established law that one "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Ecolochem, Inc. v. Southern California Edison Company, page 23, September 7, 2000 (Fed. Cir.) (citing In re Fine, 837 F.2d 1071, 1075, 5, USPQ2d 1780, 1783 (Fed. Cir. 1988)).

"Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight." Ecolochem at 24 (citing In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." Ecolochem at 24 (citing In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1988), citing In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). Additionally, "defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." Ecolochem at 24 (citing Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998)).

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. V. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). For at least the above reasons, Applicant respectfully requests that the rejection of claim 1 be withdrawn and claim 1 be allowed.

Claims 2, 4, and 7 depend from claim 1. By virtue of this dependency, Applicant submits that claims 2, 4, and 7 are allowable for at least the same reasons given above with respect to claim 1. In addition, Applicant submits that claims 2, 4, and 7 are further distinguished over *Franke* by the additional elements recited therein, and particularly with respect to each claimed combination. Applicant respectfully requests, therefore, that the rejection of claims 2, 4, and 7 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

Conclusion

Based on at least the foregoing amendments and remarks, Applicants submit that claims 1, 2, 4, and 7 are allowable, and this application is in condition for allowance. Accordingly, Applicants request favorable reexamination and reconsideration of the application. In the event the Examiner has any comments or suggestions for placing the application in even better form, Applicants request that the Examiner contact the undersigned attorney at the number listed below.

Applicant believes no fee is due with this request. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. UDK-0001 from which the undersigned is authorized to draw.

Dated: June 1, 2005

Respectfully submitted,

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